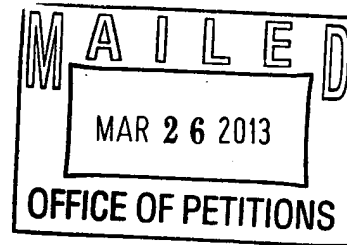




UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov



RICHARD W. HANES
HANES & SCHUTZ, P.C.
7222 COMMERCE CENTER DR.
243
COLORADO SPRINGS CO 80919

In re Patent No. 6,470,755	:	
Issued: October 29, 2002	:	DECISION ON PETITION
Application No. 09/368,549	:	
Filed: August 5, 1999	:	
Title: NOISE REDUCING	:	
DIFFERENTIAL PRESSURE	:	
MEASUREMENT PROBE	:	

This is a decision on the petition under 37 CFR 1.378(b), filed December 17, 2012, to accept the unavoidably delayed payment of the maintenance fee due at 7.5 years in the above-identified expired patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued October 29, 2002. The second maintenance fee could have been paid during the period from October 29, 2009 through April 29, 2010, or with a surcharge during the period from April 30, 2010 through October 29, 2010. Accordingly, this patent expired on October 30, 2010, for failure to timely remit the second maintenance fee.

On December 17, 2012, petitioners filed the present petition under 37 CFR 1.378(b) accompanied by the Statement of patent practitioner, Judson K. Champlin. In support of the showing of unavoidable delay, Mr. Champlin explains:

☐ On September 12, 2012, I received a file directed to the above-identified patent from the law firm which had previously responsible for prosecution and handling of the patent.

☐ By receipt of this file, I assumed that all past due maintenance fees had been paid prior to their due date.

☐ Upon further investigation of other files which I received in connection with this transfer, it became apparent that a number of due dates had been missed. On December 3, 2012, I realized that a number of US patents in connection with this transfer had not had their maintenance fees paid.

☐ On December 3, 201 (sic), I informed the client which patents had not had their maintenance fees paid and of those patents which were past their six month maintenance fee payment window.

☐ On December 7, 2012, the client instructed me that they did not intend for this patent to be abandoned and instructed me to prepare the instant Petition to revive the expired patent.

Statement, 12/17/12, p. 1.

37 CFR 1.378(b) provides that the Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable. A petition under 37 CFR 1.378(b) to accept an unavoidably delayed payment of a maintenance fee filed must include:

- (1) The required maintenance fee set forth in § 1.20 (e)-(g);
- (2) The surcharge set forth in § 1.20(i)(1); and
- (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The petition lacks item (3).

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

As language in 35 U.S.C. 41(c)(1) is identical to that in 35 U.S.C. 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), aff’d sub nom., Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff’d, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219, 1259 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963) (delay caused by a failure to act by or on behalf of the party in interest at the time the action needs to be taken is binding on the successor in title).

Initially, it is noted that Mr. Champlin assumed responsibility for the subject patent after its expiration. Therefore, petitioners must establish that they acted as a reasonably prudent person in relying on their previous legal representatives to track, notify, and pay the maintenance fee for this patent. However, petitioners did not submit any evidence that they had an ongoing contractual agreement with the previous law firm to track and pay the maintenance fees for this patent. Petitioners did not supply copies of correspondence between petitioners and the firm regarding docketing, tracking, or payment of the maintenance fee for this patent. Petitioners are reminded delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay. In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). Moreover, the

USPTO is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee. Id.

Assuming that the previous law firm assumed responsibility for the payment of the second maintenance fee, petitioners have failed to identify the error that caused the delay in timely paying the maintenance fee that led to the expiration of the patent. The Office reminds petitioners that it is their burden, not that of the USPTO, to identify the error that was the cause of the delay at issue. An adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them, as well as copies of all documentary evidence in support of the showing.

In this instance, petitioners did not provide any statements from persons, who have firsthand knowledge of the details, regarding the circumstances of the delay in payment of the maintenance fee. Petitioners did not submit any copies of their records or the records of the prior law firm with regard to the events that transpired that lead to the failure to provide timely notice of the maintenance fee due date. Furthermore, petitioners did not supply records from the prior law firm showing that it had entered the maintenance fee due date into a docketing system nor did they identify the docketing staff responsible for making the entry for this patent. Lastly, petitioners failed to show that the prior law firm's system for tracking and paying maintenance fees was reasonable reliable in view of the fact that the prior law firm missed due dates and had not paid maintenance fees in a number of patents transferred to Mr. Champlin's firm.

Any request for reconsideration should be accompanied by copies of correspondence between petitioners and the prior law firm regarding which party bore the obligation for tracking and paying the maintenance fee. If petitioners can show, by supporting documentation that the prior law firm assumed the obligation, then petitioners must demonstrate that the firm entered the patent in a reliable system for monitoring maintenance fee payments. Petitioners should submit statements from the prior law firm fully explaining its tracking system, the identity and qualifications of any support staff that managed the system, and the checks in place to ensure that the maintenance fee was timely paid. Additionally, petitioners should show that it diligently inquired with their prior legal representatives as to the status of the patent and when the maintenance was due. Lastly, petitioners must provide a thorough explanation by persons with firsthand knowledge of the events, as well as any documentary evidence, as to errors or events that occurred, which prevented the timely payment of the maintenance fee.

If the delay was caused by a docketing error on the part of an employee, it could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that reasonable steps were taken to enter the patent into the system to ensure timely payment of the maintenance fees. A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP 711.03(c)(III)(C)(2).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm’r Pat. 1988), rev’d on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm’r Pat. 1988).

In view of the above, the showing of record is inadequate to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 CFR 1.378(b). Accordingly, the petition is **dismissed**.

Petitioners should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fees and post expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioners’ request.

The Office notes that the address given on the petition differs from the address of record in the USPTO. The patent file does not indicate that patentee filed a power of attorney and change of correspondence address in this case. If the patent practitioner desires to receive future correspondence regarding this patent, he must submit the appropriate power of attorney documentation and a change of correspondence address. As a one-time courtesy, the Office is mailing a copy of this decision to the address listed on the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Registered users may also submit correspondence electronically via EFS-Web.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Cc: Westman Champlin and Kelly PA
 900 Second Avenue South
 Suite 1400
 Minneapolis, MN 55402